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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/489,884

Applicant(s)

COLBERT, TERRY R.

Examiner

David H Kruse

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1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Claim Objections

1. Claims 1, 5, 7 and 10 are objected to because of the following informalities:

At claims 1, 5 and 7 the ATCC accession number designation has been left blank.

At Claim 10 line 2, the term "of:" should be -- of --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 6, 7, 10, 11, 14, 15, 18, 19, 23, 24, 25, 27, 28, 29, 31 and 32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At Claim 6, the term "protoplasts" lacks proper antecedent basis in Claim 5.

At Claims 7, 11, 15, 19, 24, 28 and 32, the phrase "capable of expressing" is indefinite and does not state that anything is expressed.

At Claims 10, 14, 18, 23, 27 and 31, the phrase "The maize plant breeding program" lacks proper antecedent basis in the preceding claims from which they depend, drawn to a "method" rather than a "breeding program".

At Claims 11, 15, 19, 24, 28 and 32, the phrases "exceptional yield ability", "high quality", "above average Gray Leaf Spot tolerance", "good tolerance to Fusarium Ear

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Rot" and "particularly suited" are relative and do not state the metes and bounds of the claimed invention.

At Claims 25 and 29, the phrase "A hybrid maize plant according to claim 20" is indefinite and should recite -- The hybrid maize plant... --.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cunnyingham (US Patent 6,087,564, filed 13 February 1998).

Cunnyingham teaches the hybrid maize plant 34P93 and seed having white kernel and cob color, dark green leaves and light green silk color (columns 11-14). In addition, Cunnyingham teaches a method for developing a maize plant in a maize plant-breeding program using the hybrid maize plant 34P93 (Claim 12).

Cunnyingham does not teach the hybrid maize seed designated 33T17 specifically.

Hence, it would have been *prima facie* obvious for one of ordinary skill in the art at the time of Applicant's invention to use the teachings of Cunnyingham to develop the hybrid maize of the instant application. Given the similar characteristics between the hybrid maize plant 34P93 of Cunnyingham and that of the instant invention, one of skill

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in the art would have been motivated to transfer into the hybrid maize plant of Cunnyingham other characteristics that would be desirable in a hybrid maize plant.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 11, 15, 19, 24, 28 and 32 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Cunnyingham (US Patent 6,087,564, filed 13 February 1998).

Cunnyingham discloses a hybrid maize plant having good tolerance to Fusarium Ear Rot and high quality (columns 11-14). The prior art plant differs from the claimed plant only in its derivation from the plant of claim 2.

However, it is unclear how far removed the ancestor of claim 2 is from the claimed maize plant. Because such a maize plant could be many generations removed from the hybrid maize plant 33T17 Wherein 33T17 genetic material is lost with each generation, the claims essentially read on any maize plant having only two 33T17 traits. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products.

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Conclusion

8. No claims are allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Paula Hutzell can be reached at (703) 308-4310. The fax telephone number for this Group is (703) 308-4242 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the William Phillips whose telephone number is (703) 305-3419.

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180-1638



David H. Kruse, Ph.D.
29 June 2001